

REMARKS

The Office Action of February 23, 2005, has been carefully considered. The examiner has rejected claims 1-4 and 7 as anticipated by Rende. Rende has a light glued to the bottom of the housing to provide a penlight (see column 5, lines 4-8). There is no suggestion in Rende that this light be used to illuminate at least that portion of the interior of a finger under its nail so that an intersection between the extending portion of the nail and the finger is clearly visible. The light of Rende is simply taught as being useful as a pen light.

The examiner's rejection, however, is understood and claim 1 has been amended to limit the claimed assembly to one that has a holder which extends substantially rearwardly past the joined end of the nail clipper to assist in operating the nail clippers. Claim 1 also requires that the light be positioned so that it will illuminate the interior of the finger under the nail so that the intersection between the extending portion of the nail and the finger is clearly visible. A nail clipping assembly which has these two features is not anticipated by Rende. Thus, claims 1-4 and 7 are believed clearly allowable.

Claims 5 and 6 were rejected as obvious over Rende. It is submitted that Rende teaches a bulb which provides a pen light and contains no suggestion whatsoever that the light bulb has a tip that is within at least 1/8" from a fingertip portion of the subject's finger.

The only teaching in Rende about positioning the light is provided by Figure 4 of Rende where the light is shown behind the pen 24 shown in Figure 4. It is clear from Figure 4 that the light could not be in front of the pin 24 and that it could not physically be over the pin 24 and thus clearly is behind the pin 24. This places the light far further back than about 1/8". Since the light is taught strictly as being useful as a pen light, there is no suggestion that moving the light

forward would be in any way useful. Thus, clearly, Rende does not teach the limitation of claim 5 wherein the bulb is so very close to the fingertip of the finger with the nail being clipped. Applicants' invention, as set forth in claim 5, is to provide a light source such as an incandescent bulb or an LED or other source of light which is very close to the fingertip. 1/8" is almost in a touching mode which is especially useful in causing the light to pass through the fingertip and illuminate the intersection between the nail and the finger. As set forth in MPEP §2142:

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all the factual information, the examiner must then make a determination whether the claimed invention as a whole would have been obvious at that time to that person."

Clearly, there was no hint in Rende to place the light as called for in claims 5 and 6.

The examiner points to claim 6 of Rende. It is submitted that claim 6 merely reinforces the use of Rende's electric light as a pen light and not as a finger illuminating light. Claim 6 actually teaches away from the concept of lighting a fingertip since with the applicants' device, the fingertip is within at least about 1/8" from the bulb. Thus, instead of illuminating a region beyond the first end of the elongated member, applicant's device basically stops illuminating just about at the first end instead of beyond as a pen light would.

The examiner also refers to In re Aller, et al. The Aller case states at page 235:

"Normally, it is to be expected that a change in temperature or in concentration, or in both, would be an unpatentable modification.

Under some circumstances, however, changes in such as these may impart patentability to a process if the particular range is claimed to produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art."

In fact, applicants' positioning of the light bulb very close to the fingertip does produce new and unexpected results - namely, the illumination of the finger tip and the finger nail intersection.

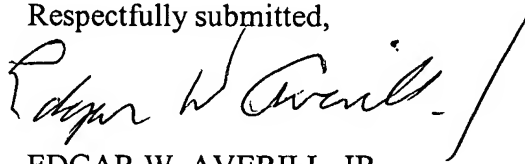
Thus, this is not discovering an optimum or workable range, but is instead positioning a light to provide an entirely new and different result from that taught by Rende. This result of lighting the finger tip is especially useful when cutting the fingernails of infants. Enclosed is a one-page article on "Cutting Baby's Fingernails" which suggests that the baby's fingernails should be cut while the baby is in a state of deep sleep. If this is done at night, turning on the room light may well wake the baby and defeat the desired process of cutting fingernails during a deep sleep. By utilizing a light positioned close to the baby's finger tip, it is not necessary to turn on a room light and it is more likely that the baby will continue in a deep sleep as desired. Also, in the enclosed article, it states:

"Drawing a drop of blood is part of learning nail trimming."

With applicants' device this possibility is greatly reduced. Also enclosed is a one-page photograph showing the effect of the light on a fingernail. As shown in the photograph, the intersection between the fingernail and the finger is readily exposed by the positioning of the light with respect to the finger tip.

It is believed that applicants' invention is neither anticipated nor suggested by the Rende
pen light teaching and allowance of all claims as amended is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Edgar W. Averill, Jr.", followed by a long horizontal flourish.

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